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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,182	01/07/2002	Georg Gros	DNAG 227 - PFF/JRC	1252

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EXAMINER	
TSOY, ELENA	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,182	GROS, GEORG	
	Examiner	Art Unit	
	Elena Tsoy	1762	

-- The MAILING DATE of this communication appears n the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *71-122* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *71-122* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Response to Amendment

1. Amendment filed on December 3, 2004 has been entered. Claims 26, 28-31, 33-35, 46, 48-50, 59-70 have been cancelled. New claims 71-122 have been added. Claims 71-122 are pending in the application.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Rejection of claims 63-66 under 37 CFR 1.75 as being a substantial duplicate of claims 59-61 respectively has been withdrawn due to cancellation of the claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 71, 72-94, 99-122 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite "... wherein the slidable anticorrosive layer is

electroconductive and the electroconductivity of the laver is provided **only** by said inorganic pigment", which was not described in the specification. The specification as filed and originally filed claims disclose either a conductive pigment (See specification, page 2, paragraph 4, line 4) of a **mixture** of the recited conductive inorganic pigments (See examples 1-6).

The Examiner's Note: although no electroconductivity of pigments recited in the claims is mentioned in the specification as filed and originally filed claims, the Examiner agrees with the Applicants that the recited conductive inorganic pigments are electroconductive inherently.

6. Claims 87-89 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite "... a mixture consisting of a polymeric organic binder, a low-molecular monomeric liquid compound to be subjected to free-radical polymerization, a compound forming radicals under the influence of actinic radiation, and at least 10 % by weight of a conductive inorganic pigment" which was not described in the specification.or in originally filed claims. The specification as filed describes a mixture *consisting of* **more than one** of either a polymeric organic binder, a low-molecular monomeric liquid compound to be subjected to free-radical polymerization, a compound forming radicals under the influence of actinic radiation, or at least 10 % by weight of a conductive inorganic pigment.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 81, 90, 93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 81, last line, "wherein said coating and said curing are effected in one step" renders the claim indefinite because it is not clear how the coating and curing can be done in one step. For examining purposes the phrase was interpreted as "wherein said curing is effected right after said coating is applied".

Claim 90, line 4, "by the method as claimed in claim 63" renders the claim indefinite because claim 90 depends on cancelled claim 63. For examining purposes the phrase was interpreted as "by the method as claimed in claim 87".

Claim 81, line 2, "wherein said coating and said curing are effected sequentially in one step" renders the claim indefinite because it is not clear how the coating and curing can be done sequentially in one step. For examining purposes the phrase was interpreted as "wherein said curing is effected right after said coating is applied".

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. **Claims 71-94, 99-122** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulkarni (US 6,054,514) and Odawa et al (US 5,578,669) for the reasons of record as set forth in

Paragraph No. 11 of the Office Action mailed on August 30, 2004 because claimed amounts of pigments can be determined Kulkarni and Odawa et al through routine experimentation in the absence of a showing of criticality. And **nowhere** in the specification is shown the **criticality** of claimed amounts of pigments.

11. **Claims 71-94, 99-122** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulkarni (US 6,054,514) and Odawa et al (US 5,578,669) in view of Sobata et al (US 4,939,034) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on August 30, 2004.

12. **Claims 81, 83, 85, 87, 89, 91, 94, 96, 97, 113, 114, 117-122** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristowe et al (US 4,213,837) for the reasons of record as set forth in Paragraph No. 13 of the Office Action mailed on August 30, 2004 because claimed amounts of pigments can be determined Kulkarni and Odawa et al through routine experimentation in the absence of a showing of criticality. And **nowhere** in the specification is shown the **criticality** of claimed amounts of pigments.

13. **Claims 81, 83, 85, 87, 89, 91, 94, 96, 97, 113, 114, 117-122** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristowe et al (US 4,213,837 in view of Sobata et al (US 4,939,034) for the reasons of record as set forth in Paragraph No. 14 of the Office Action mailed on August 30, 2004.

14. **Claims 71-80, 82, 84, 86, 88, 90, 92, 93, 95, 98-112, 115, 116** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristowe et al (US 4,213,837/in view of Sobata et al (US 4,939,034), further in view of Kulkarni (US 6,054,514) for the reasons of record as set forth in Paragraph No. 15 of the Office Action mailed on August 30, 2004.

Response to Arguments

15. Applicants' arguments filed December 3, 2004 have been fully considered but they are not persuasive.

Applicants argue that Sobata et al teach away from using amounts of less than 30% and greater that 70 % of electrically conductive pigments, and the claimed range of Applicants is, therefore, not suggested by Sobata et al.

The Examiner respectfully disagrees with this argument. First of all, Sobata et al teach **15-86 wt %** of conductive pigments, *preferably* 30 wt %-70 wt% (See column 11, lines 44-47).

Secondly, Applicants' claimed ranges of "at least 10 wt %", "at least 20 wt %" and "at least 20 wt % to at least 40 wt %" of a conductive inorganic pigment include a conductive pigment in a range from 10 wt % to ***unlimited*** amount, including 86 wt %. Therefore, claimed ranges overlap or lie inside ranges disclosed by Sobata et al.

It is held that in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. See MPEP 2144.05. Therefore, claimed ranges of "at least 10 wt %", "at least 20 wt %" and "at least 20 wt % to at least 40 wt %" of a conductive inorganic pigment are obvious over Sobata et al.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

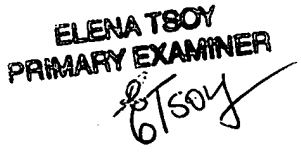
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elena Tsoy
Examiner
Art Unit 1762

December 27, 2004